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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,590	12/28/2005	Shouzi Yamazaki	SHM-16349	8274
40854	7590	02/25/2008		
RANKIN, HILL & CLARK LLP 38210 Glenn Avenue WILLOUGHBY, OH 44094-7808			EXAMINER YAGER, JAMES C	
			ART UNIT 4145	PAPER NUMBER
			MAIL DATE 02/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,590	Applicant(s) YAMAZAKI, SHOUZI	
	Examiner JAMES YAGER	Art Unit 4145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20051228</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wycech (US 4,751,249).

Regarding claims 1-3, Wycech discloses a skeleton structural member (Fig 1., 10, 12) for use in a transport machine (C3/L45-50, Fig. 1, automobile), comprising: a hollow skeleton member; multiple granules packed inside the skeleton member (C2/L25-40, plurality of pellets, Fig. 4) and/or a space bounded by the skeleton member and a panel member peripheral to the skeleton member; and a partition wall member formed by expanding at least one partition wall forming member provided inside the skeleton member and/or space, for forming a closed space to be packed with the multiple granules ((C2/L25-40, matrix of expanded polystyrene, Fig. 4), wherein the partition wall member expands more quickly than the multiple granules expand (C2/L65-C3/L6, polystyrene expanded about the pellets, Fig. 4) and wherein the partition wall forming member is made of a foaming resin material (C2/L25-40, polystyrene) .

Regarding the method limitations recited in claim 2, the examiner notes that even though a product-by-process is defined by the process steps by which the product is

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made, determination of patentability is based on the product itself. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated in Thorpe, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wycech (US 4,751,249) in view of Bock et al. (2003/0057737).

Regarding claim 4, Wycech discloses a method for manufacturing a skeleton structural member to be used in a transport machine (C1/L7-20), said skeleton structural member having multiple granules packed inside a skeleton member and or a space bounded by a skeleton member and a panel member peripheral thereto (C2/L25-40, plurality of pellets, Fig. 4), the manufacturing method comprising the steps of: disposing a plurality of partition wall forming members for forming partition walls inside the skeleton member and/or space inside a vessel or a bag (C2/L64-C3/L5); placing the granules between the plurality of partition wall forming members; disposing the vessel and its contents or the bag and its contents inside the skeleton member and/or space; and heating the vessel and contents of the vessel or the bag and contents of the bag (C3/L63-66, Fig. 6).

Wycech does not disclose disposing the partition wall forming members apart from each other.

Bock discloses a method of manufacturing a skeleton structural member to be used in a transport machine ([0009]), Fig. 5), the manufacturing method comprising the steps of: disposing a plurality of partition wall forming members for forming partition walls inside the skeleton member and/or space apart from each other inside a vessel or a bag ([0008], Fig. 4); disposing the vessel and its contents or the bag and its contents inside the skeleton member and/or space (Fig. 5); and heating the vessel and contents of the vessel or the bag and contents of the bag ([0031]). Bock further discloses that the partition walls are made of a foaming resin material ([0010]) and that the method

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increases the stiffness, strength, durability, sealing and sound absorption/dampening properties of the skeleton structural member ([0027]).

Wycech and Bock are analogous art because they both teach methods of manufacturing skeletal structural members for vehicles comprising disposing partition walls made of foaming resin materials. Therefore, it would have been obvious to one of ordinary skill in the art to use the step of disposing the partition wall forming members apart from each other as taught by Bock in the method of manufacturing a skeletal structural member of Wycech in order to provide a method of manufacturing a skeleton structural member that produces a skeleton structural member with increased stiffness, strength, durability, sealing and sound absorption/dampening properties.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES YAGER whose telephone number is (571)270-3880. The examiner can normally be reached on Mon - Thurs, 7:30am-5pm, EST, Alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Basia Ridley can be reached on 571 272-1453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY 2/7/08

/Basia Ridley/
Supervisory Patent Examiner, Art Unit 4145